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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,244	10/17/2001	Michael H. D'Amico	13253US01	7628

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EXAMINER

BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/982,244	Applicant(s) D'AMICO ET AL.	
	Examiner Julie K. Brockett	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 11-31, 33, 35-48, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-31, 33, 35-48, 64, 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claims 11, 28 and 35 are rejected under 35 U.S.C. 112 fourth paragraph as failing to further limit the subject matter of a previous claim. Claims 11, 28 and 35 all recite that the identification of the location comprises a map. This limitation is clearly now stated in independent claims 1 and 24 so the dependent claims 11, 28 and 35 fail to further limit the subject matter of a previous claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 11-13, 15, 24-31, 35, 36, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen et al., U.S. Publication No. 2003/0054868 A1 in view of Paulsen, U.S. Publication No. 2002/0142846 A1 in view of Dubno et al. U.S. Patent No. 4,722,053 in

further view of Hammond et al., U.S. Publication No. 2002/0133418 A1.

Paulsen 2003/0054868 discloses a gaming system comprising memory, a service station and a first gaming location enabling play of a game by a player. An apparatus enables communication with the service station and the first gaming location. An interactive first communication unit is operable from the first gaming location and includes a first display visible from the first gaming location and displaying a message unrelated to the play of the game without interrupting the game (See Paulsen 2003 Figs. 1 & 3C; ¶0115). A first menu of services available for selection by the player and a second menu responsive to selection of one of the services available by the player wherein the second menu displays a plurality of second menu items available for selection by the player are displayed (See Paulsen 2003 Fig. 3C; ¶0066). The first communication unit responds to a selection by the player to enable an order of a selected item from the service station (See Paulsen 2003 Fig. 3C; ¶0066) [claims 1, 24]. For example, the first menu, i.e. message, has “restaurants” and “entertainment” listed. Once a player selects restaurants, a second menu appears that lists specific restaurants. The player then “orders” the reservation and the reservation is sent to the service station. It is inherent to the system that an interactive second communication unit is operable from the service station, including a second display visible from the service station and is arranged to display the order and an identification of the gaming location requesting the order. For example, the restaurant would have to have a display

to see the reservation that was ordered. A message generated at the service station comprises a reply to a message generated at the first gaming location (See Paulsen 2003 ¶0066) [claim 25]. For example, a confirmation message for the reservation is sent. The first display comprises a touch screen display (See Paulsen 2003 ¶0034) [claims 2]. The first gaming location comprises a gaming machine and the first display is coupled to the gaming machine (See Paulsen 2003 Fig. 1) [claim 4]. A keypad is also operable from the gaming location. Consequently, the step of generating messages at the first gaming location comprises entering data from the keypad. (See Paulsen 2003 Fig. 4A) [claims 5, 29]. Furthermore, the message includes generating an image of at least one of a numeric input and an alphabetic input and generating a message in response to touching the image [claim 30]. The first communication unit displays an image on the first display suitable for entry of at least one of numeric data and alphabetic data by touching the first display (See Paulsen 2003 Fig. 3E) [claims 6, 31]. The first menu, i.e. a message, displays a plurality of types of personal service available according to the preferences of the player [claims 12, 36]. Furthermore, the second menu displays a plurality of reservation services available (See Paulsen 2003 Fig. 3C) [claims 13, 37]. Therefore, the first display displays the first and second menus sent to the first display from the memory, i.e. displaying a message generated at the service station (See Paulsen 2003 Fig. 3C; ¶0061) [claims 15, 39]. The gaming system comprises a central authority and a card reader. The card reader is operable

from the first gaming location and arranged to read a code from a card entered by the player at the first gaming location (See Paulsen 2003 ¶0007-¶0008).

The preferences of the player may comprise authorizing the first player to be located. For example, when a player authorizes the casino to enroll them in the player tracking program, the preference of allowing the casino to locate the player is now stored on the tracking card. A code corresponding to the first player can be read from the card. Stored preferences are accessed in response to the code. An identification of the location of the first player is generated (See Paulsen 2003 ¶0049-0051) [claims 9, 27, 33]. Paulsen 2003 discloses that the gaming services are customized to the player's preferences but lacks in stating that the preferences are stored in memory.

Paulsen 2002/0142846 A1 teaches of an interactive game playing preferences in which player preferences are stored in a player account, i.e. memory, before any game play. The preferences are implemented in the gaming machine upon game play. A first menu displays a plurality of types of personal service available according to the preference of the player.

Consequently, a message may be displayed depending on a preference of the player (See Paulsen 2002 ¶0010, ¶0033) [claims 1, 24]. It would have been obvious to one of ordinary skill in the art to store the player preferences in memory before the message is displayed at the first gaming location before the preferences are implemented in the gaming machine. By storing the preferences in memory, they can be recalled at any time and the player does

not have to customize their preferences every time they play the game. Upon calling up a player's preferences from memory, they are immediately added to the game environment. Paulsen lacks in specifically disclosing recommending an alternative to the player for display.

Dubno et al. teaches of a video game and service station in which an interactive second communication unit is operable from the service station and includes a second display visible from the service station. Furthermore, a network is arranged to transmit data so that messages are displayed on the first display and the second display. The second communication unit displays an image on the second display suitable for entry of at least one of numeric data and alphabetic data [claim 7]. Consequently, messages are generated at the service station and the service station displays messages interactively [claims 1, 24]. The generated messages are transmitted (See Dubno Figs. 1 & 3; col. 2 lines 15-20, 61-67). Furthermore, the second display displays a message comprising data entered by a keypad (See Dubno col. 3 lines 46-52). The message generated at the service station comprises a message generated at the first gaming location (See Dubno col. 2 lines 61-67). For example, if a player places an order the kitchen staff can respond to that message that they are out of that item. Consequently, a message generated at the first gaming location can comprise a reply to a message generated at the service station [claim 26]. For example, the player may place a second order when they are told that their first order is not available. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to include a second communication unit operable at the service station in the invention of Paulsen. When a player requests a service, such as food, it is obvious that the food authority would respond back to the player confirming the player's order. Also the use of a second display at the service station allows them to visually see the orders in order to fulfill them. It would have also been obvious for the second display to be a touch screen display [claim 3]. Touch screens are common throughout the art and simplify the inputs that a user must use to enter in a selection.

Paulsen and Dubno lack in disclosing that the identification of the gaming location comprises a map. Hammond et al. teaches of a remote device in which customers may submit orders for food, drinks, etc. The service station includes an interactive second communication unit including a second display visible from the service station arranged to display the order and an identification of the gaming location requesting the order. The identification of the gaming location comprises a map (See Hammond ¶0154, ¶0160) [claims 1, 11, 24, 28, 35]. For example, a player can place an order from the remote device, either at a table or another location such as a waiting area. The location of the player is sent to the service station employee. If the player is seated at a table, the employee can see the location of the table on a map. It would have been obvious to one of ordinary skill in the art to include a map illustrating the location of a customer so that the order is delivered to the

correct customer. Hammond clearly illustrates that the invention can be used in a casino and when a player places an order in a casino an employee may not easily know where the player's location is, therefore, by also showing the employee a map, the employee can properly deliver the order to the customer.

Claims 14, 16, 17, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen et al., U.S. Publication No.

2003/0054868 A1 in view of Paulsen, U.S. Publication No. 2002/0142846 A1 in view of Dubno et al. U.S. Patent No. 4,722,053 in view of Hammond in further view of Kirmse et al., U.S. Patent Publication No.

2002/0086732 A1. Paulsen and Dubno lack in disclosing entering a player's name for message transmission. Kirmse et al. teaches of an instant messaging system used during game play. A first display displays a message enabling the player to enter at least one of a name of a person, an identification of a second gaming location and a player code of a person and a message wherein the network transmits the message to the intend person or the second gaming location (See Kirmse Figs. 8-10; ¶0036) [claims 14, 38]. For example, a player must first type the name of a person in their buddy list prior to sending a message. Furthermore, the first gaming location is arranged to accommodate a first player and wherein the first communication unit enables entry by the first player of at least one of a name of a second player, an identification of a second gaming location and a second player code which comprises a player ID number and enables entry of a first message from the first gaming location (See Kirmse

Figs. 8-10; ¶0052- ¶0055) [claim 17, 40]. A central authority oversees the messaging. A second gaming location is arranged to accommodate a second player, an interactive third communication unit operable from a second gaming location, including a third display visible from the second gaming location. The third communication unit enables entry by the second player of at least one of a name of the first player, an identification of a first gaming location and a first player code and enables entry of a second message. The central authority is arranged to identify the first gaming location in response to at least one of the name of the first player, the identification of the first gaming location and the first player code and is arranged to identify the second gaming location in response to at least one of the second player name, the identification of the second gaming location and the second player code. The network is arranged to transmit data resulting in display of the first message on the third display and is arranged to transmit data resulting in display of the second message on the first display (See Kirmse Figs. 1-4, 11E) [claim 16]. For example, two players are playing games on their separate computer stations wherein both may exchange instant messages with the other during game play. The players must enter the player's name and code, i.e. ID number into their computer prior to any messaging being sent. It would have been obvious at the time the invention was made to allow players to exchange messages while playing games. Instant communication has been well known throughout the art for some time. Everyone wants to communicate with one another at a seconds

notice and while doing or playing things. Consequently, it is obvious for players to communicate with each other during game play so that they can talk about the game or other things.

Claims 18, 19, 21, 22, 41, 42, 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirmse et al., U.S. Patent Publication No. 2002/0086732 A1. Kirmse et al. discloses a plurality of gaming locations. An apparatus is used for enabling communication between a first and a second gaming locations. An interactive first communication unit is operable from the first gaming location and arranged to accommodate a first player. The first communication unit includes a first display visible from the first gaming location and enables entry of at least one of a name of a second player and a second player code, i.e. ID number, and enabling entry of a first message for the second player when the second player is not at any gaming location. An interactive second communication unit is operable from the second gaming location and arranged to accommodate a second player. The second communication unit includes a second display visible from the second gaming location and enables entry of at least one of a name of the first player and a first player code comprising a player ID number and enabling entry of a second message for the first player even when the first player is not at any gaming location (See Kirmse Figs. 8-10; ¶0052- ¶0055) [claims 18, 41]. For example, two players are playing games on their separate computer stations wherein both may exchange instant messages with the other during game play.

A player can attempt to send an instant message to another player even when the other player is not at a computer. The players must enter the player's name and code, i.e. ID number into their computer prior to any messaging being sent [claims 21, 45]. A network is used to transmit data resulting in display of a first menu including the first message and the name of the first player on the second display. The first menu enables selection of a reply menu allowing the second player to enter a reply message to the first player even when the first player is not at any gaming location [claim 42]. The network is also arranged to transmit data resulting in display of a second menu including the second message and the name of the second player on the first display. The second menu enables selection of a reply menu allowing the first player to enter a reply message to the second player even when the second player is not at any gaming location (See Kirmse Fig. 15) [claim 43]. Consequently, through using the instant messaging system, both players may write messages and respond to messages received. A central authority is arranged to identify the first gaming location in response to at least one of the name of the first player and the first player code and arranged to identify the second gaming location in response to at least one of the name of the second player and the second player code (Figs 3 & 4) [claim 19]. For example, the message cannot be sent unless they know the IP address of the computer to send it to. It is clear that an alphanumeric keypad operable from the first gaming location is used wherein the second messages comprises data entered by the keypad [claims 22, 46]. It

is well known that personal computers have keyboards and displays. While Kirmse uses a previously stored list of names of possible recipients, i.e. a buddy list, it does not have to. It is well known throughout the art to instant message a person not on one's buddy list. The player may just enter the other player's code into the instant messenger and send a message; the name of the other player does not have to be on the buddy list in order to receive the message. Therefore, it would have been obvious to one of ordinary skill in the art to send a message in Kirmse to another player who is not on the buddy list if that player wishes to invite someone else to play the game.

Claims 20, 23, 44, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirmse et al., U.S. Patent Publication No.

2002/0086732 A1 in view of Paulsen et al., U.S. Patent Application No.

2003/0054868 A1. Kirmse further discloses that both the first and second communication units display an image on one of the first and second displays suitable for entry of at least one of numeric and alphabetic data. Kirmse lacks in disclosing using a card reader. Paulsen et al. 2003/0054868 A1 teaches of a gaming system, which comprises a central authority. A first card reader is operable from the first gaming location and a second card reader is operable from a second gaming location. The first and second card readers are operable to read a code from a card entered by a player. The central authority identifies the first gaming location based on the code read at the first location and identifies the second gaming location based on the code read at the second

location (See Paulsen 2003 Fig. 4A; ¶0044) [claim 20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a card tracking system in the invention of Kirmse. As previously stated players are identified at a first location based on information input at a second location or players are identified at a second location based on information input at a first location. For example, a player enters another players ID at one location and the player is identified at a separate gaming location. By using tracking cards, one could locate players based on their card number instead of their IP address or username. Furthermore, the card can hold other information valuable to a player. Kirmse further lacks in disclosing a touch screen display. Paulsen clearly teaches of the uses of touch screen displays (See Paulsen 2003 Fig. 1) [claims 23, 44, 47, 48]. It would have also been obvious for the displays to be touch screen. Touch screens are common throughout the art and simplify the inputs that a user must use to enter in a selection.

Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen et al., U.S. Publication No. 2003/0054868 A1 in view of Paulsen, U.S. Publication No. 2002/0142846 A1 in view of Dubno et al. U.S. Patent No. 4,722,053 in view of Hammond in further view of LeMay, U.S. Patent Publication No. 2003/0032479 A1. Paulsen and Dubno lacks in disclosing having a player locate another player. LeMay teaches of a gaming system in which a player may locate another player (See

LeMay ¶0115). It would have been obvious to one of ordinary skill in the art at the time the invention was made to give a player the ability to locate another player so that they may have a conversation with each other. By knowing that a player is in a casino, one knows that they can then communicate with the other person.

Response to Amendment

It has been noted that claims 1, 14-16, 18, 19, 24 and 38-41 have been amended.

Response to Arguments

Applicant's arguments filed February 2, 2004 have been fully considered but they are not entirely persuasive. Applicant's arguments with respect to the 112 rejections are persuasive and those rejections have been withdrawn. However, Applicant's rejections with respect to the prior art are not persuasive.

Applicant argues that none of the cited references teaches or suggests a gaming system whose service station, when displaying an order, displays an identification of the gaming location requesting the order that includes a map. The Examiner agrees that it is not inherent in Paulsen 2003 to include information about the location of a reservation. However, Dubno and Hammond both disclose this limitation. The Examiner notes that Giraladin discloses using a map for locating people, which is a common practice, but it

did not disclose locating people who placed orders. Therefore, the new reference Hammond has now been added which discloses a food ordering system in which players on remote devices, which may also be used for gaming, place orders and the display at the service station can display the order as well as a map of where the customer is located, i.e. table number or restaurant location. The Examiner further points out that the concepts of using maps to locate a specific location have been for thousands of years and Applicant is merely using a map to locate where a customer is. This is an obvious use of a map, for example, when you don't know exactly where someone is, you look at a map. The fact that the use of a map is being used in the context of placing an order does not render it non-obvious.

Applicant also argues that Kirmse does not teach of the ability to write messages when one client is offline and thus not able to receive the message. The Examiner disagrees. While the Examiner does agree, that a client in Kirmse will not receive a message unless they are online, this does not prevent another client from entering a message to a client who is offline. For example, if I instant message my friend when they are not online, the message gets entered and sent, it's just that since the friend is not online they will not receive the message. Applicant's claims recite entry of the message only and do not recite anything to do with receiving the message while off-line or saving the message till one is online (which is the basics of e-mail). Consequently, Kirmse teaches Applicant's invention.

Applicant further argues that it is not obvious to implement a card tracking system into the invention of Kirmse since in an Internet gaming environment; a card tracking system would be useless and impractical. The Examiner disagrees and notes that the Internet is used to play many casino games including poker, craps, slots etc. All of these games are known to use card-tracking systems in casinos. Therefore, when these games are on the Internet, it is obvious to continue to use card tracking systems so that player's can be rewarded for the games they play and the money they spend. Just because a game is played over the Internet does not make card tracking useless or impractical.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in cursive script, reading "Julie K. Brockett".

Julie K Brockett
Primary Examiner
Art Unit 3713